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APPLICATION NO. FILING DATE		FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/939,883	08/27/2001	Volker Breu	20725	4828	
151	7590 04/21/2004		EXAM	NER	
HOFFMAN - PATENT LA	N-LA ROCHE INC. W DEPARTMENT	(PE W)	TRUONG, TAN	THOM NGO	
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Please find below and/or attached an Office communication concerning this application or proceeding.

RESPONSE DUE:

STATUTORY

PERIOD EXPIRES:

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	2006	Application	No.	<i>/</i>	Applicant(s)	
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Office Action Summa	ny d	Examiner	<u></u>		Art Unit	
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A SHORTENED STATUTORY PER THE MAILING DATE OF THIS COM - Extensions of time may be available under the p after SIX (6) MONTHS from the mailing date of t - If the period for reply specified above is less that - If NO period for reply is specified above, the mail - Failure to reply within the set or extended period Any reply received by the Office later than three	MMUNICATION. rovisions of 37 CFR 1.13 his communication. n thirty (30) days, a reply kimum statutory period for reply will, by statute, months after the mailing	36(a). In no eventy within the statuto will apply and will a cause the applica	t, however, may a ory minimum of thi expire SIX (6) MO ation fo become A	reply be timel irty (30) days v NTHS from the ABANDONED	y filed vill be considered tim mailing date of this (35 U.S.C. § 133).	nely.
earned patent term adjustment. See 37 CFR 1.7	704(b).					
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Disposition of Claims						
4)⊠ Claim(s) <u>1-6,8, 9, 11-15,17-38</u>				n the appli	cation.	
4a) Of the above claim(s)		vn from cons	ideration.			
5) Claim(s) is/are allowed						·
6) Claim(s) 1-4,6,14,15,17-19,48				-		
7)⊠ Claim(s) <u>2-4,11-13,20-38,50-5</u> 8)□ Claim(s) are subject to				are objecte	ed to.	
8) Claim(s) are subject to	resulction and/or	election req	uirement.			
Application Papers						
9) The specification is objected to	by the Examiner	•	•			
10)☐ The drawing(s) filed oni	is/are: a) <u>□</u> acce	epted or b)	objected to	by the Ex	aminer.	
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11)☐ The oath or declaration is object	cted to by the Exa	aminer. Note	the attached	d Office A	ction or form P	TO-152.
Priority under 35 U.S.C. § 119					•	
12) Acknowledgment is made of a a a a large a) All b) Some * c) None		priority unde	r 35 U.S.C. §	§ 119(a)-(d	d) or (f).	
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* See the attached detailed Office	action for a list o	of the certified	d copies not	received.		
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Attachment(s) 1) Notice of References Cited (PTO-892)		41	Intension: S	Summer: (C3	CO 412\	
2) Notice of Draftsperson's Patent Drawing Rev	view (PTO-948)	4)	Paper No(s	Summary (P1 s)/Mail Date.		
3) Information Disclosure Statement(s) (PTO-1 Paper No(s)/Mail Date <u>4.6</u> .	449 or PTO/SB/08)	· 5)			nt Application (PT	O-152)
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Application/Control Number: 09/939,883

Art Unit: 1624

DETAILED ACTION

Applicant's amendment of 01-23-04 has been considered. The amended claims have overcome the previous rejection of 112/2nd by amending the definition of R⁸ to include "alkylene", and not "alkyl". Also, claim 49 has been amended to recite "R⁸" as opposed to R⁹. Thus, the previous 112/2nd rejection is withdrawn herein.

Claims 7, 10, 16, 39-47, 79-81, 87-91, and 97-145 have been cancelled. Therefore, only claims 1-6, 8, 9, 11-15, 17-38, 48-78, 82-86, and 92-96 are pending.

The cancellation of non-elected subject matter is appreciated.

An update search yields a reference having one common inventor, and thus, prompts the following new ground of rejection.

Double Patenting

The **nonstatutory double patenting** rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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1. Claims 1-4, 6, 14, 15, 17-19, 48, 49, 59, 70-72, 75, 76, 82-84, and 92 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5-9 of U.S. Patent No. 6,696,467 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds of formula I of US'467 overlap with those of the instant formula I when the reference's R¹ and R² "form a 5- to 10-membered heterocyclic ring", which reads on the definition of the instant R³ as a a heteroaryl group. Although claim 1 of US'467 does not indicate whether the heterocyclic ring is aromatic, in the specification, the examples of such a heterocyclyl group include pyridinyl, fury, thiophenyl which are aromatic. Thus, it would have been obvious the scope of formula I in US'467 encompasses the scope of the instant formula I.

Claim Objections

- 2. Claims 2-4, 11-13, 20-38, 50-58, 60-69, 73, 74, 77, 78, 85, 86, and 93-96 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
- 3. Also, claim 11 is an improper dependent claim because it depends on the cancelled claim 11.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M-F (\sim 10 am \sim 6:30 pm).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at 571-272-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting SPE of 1624, at 571-272-0661.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

PRIMARY EXAMINER

r. Truong

April 15, 2004

Notice of References Cited

Notice of References Cited

TRADEN TO Tamthom N. Truong

Applicant(s)/Patent Under Reexamination BREU ET AL.

Examiner

Tamthom N. Truong

Applicant(s)/Patent Under Reexamination BREU ET AL.

Page 1 of 1

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Date of Publication of

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E TRA Complete if Known INFORMATION DISCLOSURE 09/939,883 Application Number August 27, 2001 STATEMENT BY APPLICANT Filing Date DEC 3 1 2001 Volker Breu et al. First Name Inventor (Use several sheets if necessary) 1614 1624 Group Art Unit **Examiner Name** Attorney Docket Number 20725 RANKASAS of Sheet **U.S. PATENT DOCUMENTS**

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